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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,667	06/29/2001	Koichiro Akiyama	210683US2SRD	9366

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EXAMINER

GREENE, DANIEL L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/893,667

Applicant(s)

AKIYAMA, KOICHIRO

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date various.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 7/5/2005 have been fully considered but they are not persuasive. The amendments create Claim Rejections - **35 USC § 101** because the amendment is inoperative and therefore lacks utility. The Applicant amended by adding:

receiving encrypted first key information ... and broadcasted ...

decrypting the encrypted first key to obtain second key information.

storing the second key information ...

The Examiner submits that when the first key information is decrypted, the only item available is the decrypted first key information. The decrypted first key could then be used to accomplish another task such as obtaining second key information. The claim as written is inoperative.

However, Kambayashi discloses to transmit a decoding key through a network, the decoding key is often reencrypted using another key. Col. 13, lines 35-37. Further, Kambayashi teaches according to the present invention, there is provided an information usage apparatus, which receives, encrypted first key information for decoding encrypted contents information and first key generation information necessary for generating second key information for decoding the first key information and decodes and uses the contents information, wherein second key generation information necessary for generating the second key information for decoding the first key information is held, the second key information is generated on the basis of the second

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key generation information and the input first key generation information, and the encrypted contents information is decoded using the generated second key information.

The Applicant further argues that Kambayashi fails to disclose or suggest the feature ...” periodically updating the contract information...”. The last Office Action directed the Applicant to Col. 39, lines 33-67 which teaches about a predetermined ... update time. Further, the term “periodically” is not space or time specific rendering it open for interpretation in the broadest sense? The Applicant submits in his argument that Kambayashi determines whether the contract is valid or invalid, and the contract is updated. Page 16, 1st paragraph. Further, Kambayashi discloses about the use and function of “the license information update unit...” Col. 27, lines 51-67.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 3,6 and 21 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The Applicant states:

receiving encrypted first key information ... and broadcasted ...

decrypting the encrypted first key to obtain second key information.

storing the second key information ...

The Examiner submits that when the first key information is decrypted, the only item available is the decrypted first key information. The claims, as written, do not provide information on the origination or source of the second key information.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 2, 3, 6, and 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the term "second key". However, as the claims are written, there is only one key. There is no second key. Decrypting the first key will only provide a decrypted first key.

4. Further, the claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with idiomatic errors. It is clear from the claims that there is only one key. However, the Applicant refers to two keys.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kambayashi et al. U.S. Patent 6,477,649 [Kambayashi].
3. As per claims 1, 2, 3, 6, 9, 10, 11, 14 and 20:

The recitations, a broadcast receiving method, a broadcast receiving apparatus, a method of distributing information, and an information distributing apparatus, has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951)

Kambayashi discloses:

storing first control information in a storage device of a receiver, the first control information containing identification information unique to the receiver and contract information and required for the receiver to select broadcasted and encrypted contents information; Col. 11-12, lines 1-67.

receiving second control information with the receiver via a bi-directional communications channel, the second control information containing information for updating; Col. 38, lines 1-67.

periodically updating the contract information of the first control information in the storage device to the contract information contained in the second control information; Col. 39, lines 33-67.

receiving broadcasted key information independent from the receiver and required to decrypt the contents information; Col. 41, lines 33-67.

selecting and decrypting the contents information based on the key information and updated contract information of the first control information. Col. 42, lines 30-67.

Kambayashi teaches all of the elements claimed with the exception of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated. The examiner takes Official Notice that sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known by a person of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated because the skilled artisan would have recognized that this business practice of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known and is clearly applicable to providing a record that a system change was done and a confirmation message being generated to facilitate proof positive of the system change. These advantages are well known to those skilled in the art.

Kambayashi does not expressly show that a bi-directional communications channel sends the data. However, Kambayashi does teach transferring information through a network such as the Internet or by broadcasting. Col. 14, lines 53-56. The

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Examiner submits that a person having ordinary skill in the art would have known that the Internet is a bi-directional communications channel.

Further, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The receiving of the information would still be accomplished whether the medium used was a bi-directional channel, Internet, telephone, etc. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to transmit the information utilizing any medium available because such medium does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 4, 7, 12, and 15:

Kambayashi further discloses:

wherein the first receiver receives the second control information after the broadcast receiving apparatus is certified by the first distributor. Coil. 65, lines 1-26.

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As per claims 5, 8, 13, and 16:

Kambayashi further discloses:

wherein said first receiver sends a use history required to charge a fee for use of the contents information to the first distributor, and then receives the second control information. Col. 57, lines 35-67.

As per claims 17 and 18:

Kambayashi further discloses:

broadcasting key information to the receiver from a distributor, the key information being independent from the receiver and required to decrypt encrypted contents information, the receiver selecting and decrypting the contents information based on first control information and the key information, the first control information containing identification information unique to the receiver and required to select the contents information; Col. 11-12, lines 1-67.

distributing second control information to the receiver via a bi-directional communications channel, the second control information being for updating at least some contents of the first control information in the receiver; Col. 38, lines 1-67.

broadcasting the individual control information if receipt of the individual control information is not confirmed by the receiver. Col. 65, lines 1-67.

Kambayashi teaches all of the elements claimed with the exception of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated. The

examiner takes Official Notice that sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known by a person of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated because the skilled artisan would have recognized that this business practice of sending back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known and is clearly applicable to providing a record that a system change was done and a confirmation message being generated to facilitate proof positive of the system change. These advantages are well known to those skilled in the art.

As per claim 21:

Kambayashi discloses the claimed invention except for " a second receiver ". It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have more than one receiver, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

a storage device configured to store first control information required to decrypt broadcasted and encrypted contents information; Col. 11-12, lines 1-67.

a first receiver configured to receive second control information distributed from the first distributor via a bi-directional communication channel, the second control information containing contract information used to update at least contract information of the first control information stored in the storage device or broadcasted by the first distributor; Col. 38, lines 1-67.

a transmitter configured to transmit receipt of the information when the first receiver receives the second control information via the bi-directional communications channel; Col. 57, lines 35-67.

an update device configured to periodically update the contract information of the first control information in the storage device to the contract information of the second control information received by the first receiver; Col. 39, lines 33-67.

a second receiver configured to receive key information broadcasted by the second distributor, the key information being required to decrypt the encrypted contents information and common to a plurality of broadcast receiving apparatuses, Col. 41, lines 33-67

wherein the contents information is decrypted based on the decrypt control information stored in the storage device and the key information received by the second receiver. Col. 42, lines 30-67.

Kambayashi teaches all of the elements claimed with the exception of a certifying device configured to send back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated. The examiner takes Official Notice that a certifying device

configured to send back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known by a person of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to have included the step of a certifying device configured to send back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated because the skilled artisan would have recognized that this business practice of a certifying device configured to send back a receipt acknowledgement from the receiver via the bi-directional communication channel when the contract information of the first control information is updated is old and well known and is clearly applicable to providing a record that a system change was done and a confirmation message being generated to facilitate proof positive of the system change. These advantages are well known to those skilled in the art.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

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of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

8/31/2005


SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222